

George C. Myers III

10/073,993

02/14/2002

Amendment dated April 20, 2004

Response to Office Action dated March 9, 2004

**REMARKS**

In response to the outstanding Office Action (Paper No. 5), applicant has submitted a proposed correction to Figure 6 of the drawings and has amended claims 1 and 15 to overcome the Examiner's objection to claims 1-3, 10 and 15-20. In particular, claims 1 and 15 have been amended to delete the language "about which the hair is adapted to be wrapped" and to substitute therefor the language --adapted to have hair wrapped about it--, as suggested by the Examiner.

Claims 2 and 14 have been canceled as noted in the Listing of Claims. Claims 1, 3, 8, 13, 15 and 20 are generic to all species of the invention.

It is noted that the Examiner apparently did not act on claim 13, which applicant listed in response to the restriction requirement (Paper No. 4) as a generic claim, as well as a claim readable on the elected Species B of Figure 6. See applicant's Response to Restriction Requirement and Amendment dated January 2, 2004 at page 1. In addition, claim 8 has been amended to be generic and readable on the elected Species B of Figure 6. It is respectfully requested that the Examiner include claims 8 and 13 among the claims presently being examined. Insofar as presently understood, claims 4-7, 9, and 11-12 will be considered withdrawn by the Examiner as being directed to a non-elected species until such time as a generic claim is found allowable. Should one of the generic claims be allowed, it is understood that the Examiner will examine the non-elected claims 4-7, 9, and 11-12.

Turning now to the rejections of the claims, claims 1-3, 8 (presumed), 13 (presumed), 15,

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16, 19 and 20 have been rejected by the Examiner under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 3,441,032 to *Barrett*, and claims 10, 17 and 18 have been rejected by the Examiner under 35 U.S.C. §103(a) as unpatentable over *Barrett* in view of U.S. Patent No. 3,073,318 to *Catania*. In addition, the Examiner has cited U.S. Patent Nos. D16,710 to *Jones*; D145,079 to *Gumb*; D146,823 to *Daniels*; 3,418,194 to *Lofitice*; 5,694,955 to *Grooms*; 6,003,521 to *Huang*; and 6,386,207 to *Stewart* as "pertinent to applicant's disclosure."

As to the rejection based on *Barrett*, the Examiner has taken the position that *Barrett* discloses a hair curler with a body portion and means for holding the hair to the body portion. Although the Examiner concedes that *Barrett* does not disclose an animal head portion and animal hind portion, she notes that *Barrett* discloses an ornament in the form of a flower on each side of the body portion and calls attention to column 2, lines 50-53 of *Barrett* which states that the ornament can be "a flower or any similar decorative item." The Examiner further asserts that it would have been obvious to one of ordinary skill in the art at the time the invention was made to include an animal head portion and an animal hind portion in place of the flower ornaments of *Barrett*, because it has been held that the "mere addition of an ornamental element which has no mechanical function involves only routine skill in the art," citing *In re Seid*, 73 USPQ 431 (CCPA 1947).

As to claims 10, 17 and 18, the Examiner concedes that *Barrett* does not disclose that the body portion of the hair roller comprises a mesh covered coil spring surrounding a bristle brush,

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but relies on *Catania* as disclosing that feature. The Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the body portion of *Catania* for the body portion of *Barrett*, because the *Catania* body portion allegedly is an "art recognized equivalent."

Claims 2 and 14 have been cancelled and claims 1 and 15 have been amended to overcome the Examiner's rejections of the elected claims.

Referring first to *Barrett* and the rejection based on that patent, it is noted that *Barrett* discloses a hair roller R with ornaments O that are "arranged so as to simulate a flower or any similar decorative item." The flower ornaments O are adapted to be removably or permanently attached to the opposite ends of the hair roller R or to be removably attached to the sides of the hair roller. Importantly, the flower ornaments O applied to the hair roller are identical in shape and appearance, and there is no teaching or suggestion in *Barrett* that the ornaments O applied to the opposite ends of the roller R should have a different shape and appearance. Nor is there any motivation in *Barrett* to attach differently shaped ornaments to the opposite ends of the roller R.

Amended claims 1 and 15 now recite that "said animal head portion [attached to one end of the body portion of the hair curler] ha[s] a different shape and appearance than said animal hind portion [attached to the other end of the body portion of the hair curler]." Even the teaching of *Barrett* that the ornament O may be a decorative item "similar" to a flower does not suggest that the ornaments disposed on the opposite ends of the roller have different shapes and appearances.

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Moreover, it is submitted that *Barrett's* teaching at col. 2, lines 50-53 that the ornament O may simulate a decorative item "similar" to a flower does not teach or suggest that the ornament may simulate an animal because an animal is not generally considered to be "similar" to a flower.

In support of the rejection based on *Barrett*, the Examiner cites the 1947 case of *In re Seid*, 73 USPQ 431 (CCPA 1947) for the proposition that the "mere addition of an ornamental element which has no mechanical function involves only routine skill in the art." Applicant respectfully submits that the holding of the *Seid* case is not so broad as stated by the Examiner. A careful reading of *Seid* reveals that what the Court actually held was that "[t]hose matters . . . relate to ornamentation only and have no mechanical function whatsoever." The specific "matters" the Court was referring to were the "particular shape and arrangement of the upper part of the [human] body in appellant's figure, including the arrangement of the arms" that counsel for appellant had emphasized distinguished over the human body disclosed in the applied *Kirchner et al.* patent.<sup>1</sup> In other words, in *Seid* the prior art relied upon by the Patent Office *did in fact disclose a human body* ("[t]he patent to *Kirchner et al.* discloses a display device comprising a cardboard member shaped to represent a *human body* from the waist up. . . ." Emphasis added.),

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<sup>1</sup> See MPEP §2144.04 wherein the holding in *Seid* was characterized as follows: "Claim was directed to an advertising display device comprising a bottle and a hollow member in the shape of a human figure from the waist up which was adapted to fit over and cover the neck of the bottle, wherein the hollow member and the bottle together give the impression of a human body. Appellant argued that *certain limitations in the upper part of the body, including the arrangement of the arms, were not taught by the prior art.* The court found that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art." Emphasis added.

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but the appellant argued that the shape and arrangement of the human body, especially the arms, was not taught by Kirchner et al. It is that argument the Court rejected as relating to "ornamentation only and hav[ing] no mechanical function whatsoever." Here, unlike the factual circumstances in *Seid*, the prior art patent to *Barrett* does not teach any form of animal whatsoever, and applicant here is not arguing the novelty or unobviousness of any particular shape or arrangement of the animal form *per se*. For those reasons, *Seid* is factually and legally distinguishable from this case.

Moreover, recent case law of the Federal Circuit clearly supports applicant's contention that ornamental or decorative indicia can be a basis for patentability. In the case of *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999), the Federal Circuit reversed an Examiner's rejection, upheld by the Board of Patent Appeals and Interferences ("Board"), of claims directed to a *decorative* trash bag. In *Dembiczak*, the Board determined that "the only difference between the invention presently defined in the independent claims on appeal and the orange plastic trash bags of the prior art and the use of such bags resides in the application of facial indicia to the outer surface of the bag." 175 F.3d at 998. The Board affirmed the Examiner's combination of prior art "conventional" orange plastic trash bags with a stuffed paper bag painted orange having facial features painted on the bag with black paint. The Federal Circuit reversed holding, *inter alia*, that there was no motivation for making the combination. Thus, the result of the Federal Circuit's holding was that the patentably distinguishing feature over the prior

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art "conventional" orange plastic trash bags was the "facial indicia including at least two of an eye, a nose and a mouth . . . for forming a face pattern on said orange color outer surface to simulate the general outer appearance of a decorative pumpkin with a face thereon."<sup>2</sup> That "facial indicia" unquestionably relates to "ornamentation only with no mechanical function whatsoever."

For the foregoing reasons, not only is the issue in *Seid* factually and legally distinguishable from the issue this case, the recent Federal Circuit decision in *Dembiczak* clearly holds that decorative indicia having no mechanical function at all can be a patentably distinguishing feature of an article claim in a utility patent application. See also the discussion of *Dembiczak* in MPEP §2144.04. The holding in *Dembiczak* is more in accord with other recent Federal Circuit decisions, such as *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1998), finding patentability in inventions (e.g., business methods) not specifically excluded by statute, or not a law of nature, natural phenomena or abstract ideas.

Applicant also submits that the "animal head portion" and the "animal hind portion" recited in the pending claims do, in fact, have mechanical functions albeit those functions are not expressly described in the written specification. One of those mechanical functions is clearly illustrated in Figure 1 of the drawings by the hair curler 10. In that figure, the animal head portion

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<sup>2</sup> Although in *Dembiczak* secondary considerations were argued in support of patentability, the Federal Circuit stated

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and animal hind portion function *mechanically* to prevent the hair curler from shifting axially relative to the hair. In addition, when the hair curler of any embodiment of the invention is employed, the user will necessarily and inherently grasp the "animal head portion" and the "animal hind portion" with her fingers in order to wrap the hair about the body portion of the hair curler. Thus, the "animal head portion" and the "animal hind portion" fulfill the not expressly disclosed, but clearly inherent mechanical function of providing the user with gripping surfaces for holding and rotating the hair curler during application to the user's hair. For those reasons, it is erroneous for the Examiner to suggest that the "animal head portion" and the "animal hind portion" have "no mechanical function."

Independent claims 1 and 15 have been further amended to recite that the hair curler simulates the appearance of a given animal and that the body portion of the hair curler, which is adapted to have hair wrapped about it, simulates a first part of the anatomy of the given animal. Neither *Barrett* nor *Catania*, nor any other cited reference, discloses or suggests a hair curler with a body portion about which hair is wrapped that simulates any portion of the anatomy of an animal. Claims 1 and 15 also recite that the animal head portion and the animal hind portion simulate second and third parts of the anatomy of the given animal, features also not disclosed or suggested by the cited prior art.

For all the foregoing reasons, it is respectfully submitted that the amended claims in this

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that it had "no need to address the parties' arguments with respect to secondary factors." 175 F.3d at 1001.

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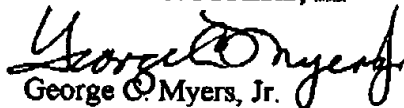
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application clearly and patentably distinguish over *Barrett* and *Catania*, alone or combined with each other or any other cited reference of record. Accordingly, allowance of the elected claims 1-3, 10 and 15-20 is respectfully requested, as well as examination and allowance of non-elected claims 4-7, 9 and 11-12 all of which depend directly or indirectly from an allowable generic claim.

In the event that any issues remain in this application that can be overcome in a telephone communication, the Examiner is invited to telephone the undersigned at (617) 241-7982.

Respectfully submitted,

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I hereby certify that this Amendment was transmitted by facsimile on April 20, 2004 to the Central Facsimile Number (703) 872-9306 in the U.S. Patent and Trademark Office.



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